

prosecution. The Examiner, however, expressed confusion over the simultaneous election of Group III (the group relating to a method of making the radiolabelled compound) with Group I in the Response to the Restriction Requirement. It is submitted that the Examiner has misunderstood Applicants' position. Because the Examiner indicated (both in the Restriction Requirement and the present Office Action) that the product claims will be examined with either (1) the method of making or (2) the method of PET imaging, it is submitted that the Response to the Restriction Requirement was proper.

It is submitted that the Response to the Restriction Requirement was an election of Group III. Group I was included in the election because of the Examiner's statements in the Restriction Requirement. Furthermore, Claim 14 was elected as the species because Group I was included in the election, as per the Examiner's comments in the Restriction Requirement, in which the Examiner stated that the examination of Group I required an election of species. Therefore, it is submitted that the Response to the Restriction Requirement was proper and it is requested that Groups I and III be examined.

Additionally, because the Examiner did not make the Restriction Requirement Final, Applicant is permitted to traverse the Restriction Requirement. It is submitted that there would be no additional burden on the Examiner to examine the remaining

groups of claims with the claims of Groups III and I. Therefore, it is requested that the Restriction Requirement be lifted in its entirety.

Claims 1, 3-6, and 8-14 have been rejected under 35 U.S.C. 103(a) as obvious in view of Wester (J Nucl. Med., 1999), Coenen (U.S. Patent No. 4,925,651) and Tomiyoshi (Nucl. Med. Comm., 1997). The Examiner has taken the position that Wester discloses the compound O-(2-[¹⁸F]fluoroethyl)-L-tyrosine for PET imaging and that this compound was formed in both the L- and D-form and in mixtures thereof. The Examiner conceded, though, that while the Wester compound is similar to the presently claimed compound, it is not an exact duplicate. Additionally, the Examiner conceded that Wester does not disclose the claimed isomers.

The Examiner advanced, though, that tyrosine and methyltyrosine are structurally obvious and analogous compounds. Further, the Examiner has argued that these compounds are known to be functional equivalents. The Examiner cited Coenen and Tomiyoshi in support of this position. Therefore, the Examiner has taken the position that in view of these three references, one of ordinary skill would find it obvious to produce the claimed compound.

It is submitted that this rejection is not well taken. It is submitted that the cited references do not teach each and every aspect of the claimed composition. It is noted that there are significant differences between the compounds of the present invention

and those of the cited references. That is, the claimed provision of the methyl group at position 2 and the positioning of the radiolabel in the species claimed in Claim 14 result in compounds that are quite different from the compounds of the cited references.

Therefore, it is requested that the rejection be withdrawn as the cited references do not teach these positioning aspects of the claimed invention.

It is further noted that the fluoro-tyrosine (^{18}F -Tyr) of Coenen is produced from $^{18}\text{F}_2$ gases, which requires the use of an electrophilic method. It is submitted that an electrophilic method would necessarily label ^{18}F and ^{123}I on the benzene ring and not on the side chain, as is the case in the present invention. Therefore, it is submitted that Coenen cannot anticipate nor can it render the claimed invention obvious as Coenen would not be able to produce the compounds of the invention. That is, Coenen could not use the disclosed electrophilic method to produce the claimed compounds.

Therefore, it is submitted that the rejection is improper for this reason. See *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) and MPEP 2143.01.

It is noted that Tomiyoshi also derives its ^{18}F -fluoro- α -methyl tyrosine (FMT) from $^{18}\text{F}_2$ gases. Therefore, the Tomiyoshi compositions would also be radiolabelled on the benzene ring, rather than the side chain, for the same reasons set forth above. Thus, Tomiyoshi cannot render the claimed invention obvious or anticipated because the Tomiyoshi invention would not be able to produce the compounds of the invention.

In other words, Tomiyoshi would not be able to use an electrophilic process or the $^{18}\text{F}_2$ gases required for its compounds in order to anticipate or render the claimed invention obvious. Therefore, it is submitted that the citation of this reference is improper for this reason.

As for the Wester reference, it is noted that the compositions of the present invention differ from the compounds of Wester as the claimed compounds have a methyl group at position 2 and a different positioning of the radiolabel in the species claimed in Claim 14. Additionally, it is noted that Wester's ^{18}F -fluoroethyl tyrosine is obtained from a nucleophilic method. The Wester reference, however, utilizes a very complex and many-stepped labeling process. Unlike Wester, the present invention uses a process that is simple and involves one step, thereby further suiting the needs of PET compounds. Therefore, it is submitted that the rejection is improper for these reasons as well.

Additionally, because Coenen and Tomiyoshi are not proper references for the reasons cited above, it is submitted that Wester is also improper as the Examiner conceded in the Office Action that Wester is insufficient to anticipate or render the present invention obvious on its own. Therefore, it is requested that the rejection be withdrawn for this reason as well.

In the event this paper is not being timely filed, the applicants respectfully petition

for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 01-2300, referencing Attorney Docket No. 107380-00005.

Respectfully submitted,



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Enclosure: Petition for Extension of Time (2 months)